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EXAMINER

GILBERT, WILLIAM V

ART UNIT	PAPER NUMBER
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3635

MAIL DATE	DELIVERY MODE
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09/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/674,097

Applicant(s)

OLAH, TIMOTHY J.

Examiner

William V. Gilbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-13, 16-21 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-13, 16-21 and 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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DETAILED ACTION

This is a Final Office Action. Claims 1, 14, 15, 22 and 23 have been cancelled. Claims 2-13, 16-21, 24-26 are pending.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites the limitation "said end members" in line 16. There is insufficient antecedent basis for this limitation in the claim. Applicant amended the claims to read "having adjacent end members thereof" line 15, and claims "end members" line 5. It is unclear as to which reference "said end members", line 16 is referencing.

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Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, 3, 5-7, 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Trimmer (U.S. Patent No. 3,447,771) as in the office action dated 15 February 2007.

Claim 3: Trimmer discloses a panel (Figure 1, element 10) having a plurality of structural members including a pair of elongated frame side members (pair of members attached to end members), and a pair of end members (14) each having a planar side surface, the side and end members are joined at the ends to form a rectangular panel with a planar outer perimeter formed by the side surfaces, a deck member (12) secured to the top side and enclosing the frame and a bracket member (30) which extends outwardly (inherent, the thickness of the bracket is an outward extension). The phrase "for connecting...said girders", lines 13, 14, is a statement of intended use of the claimed invention and must result in a structural difference between the claimed

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invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 2: the panel has fasteners (Figure 4, element 20). The phrase "enabling attachment...said girders", is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claims 5 and 6: the phrases involving adapting the frames for enablement purposes is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 7: the frame members have a C-shaped cross section and each member is positioned on the frame to enable the web to form a portion of the planar outer perimeter.

Claim 10: the panels are joined in an end-to-end fashion (Fig. 1: generally).

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Claim 12: a generally rectangular framework is connected with a plurality of side members (proximate 14) in a spanning relationship.

Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by Gilbert (U.S. Patent No. 2,484,283) as in the office action dated 15 February 2007.

Claim 4: Gilbert discloses a plurality of structural side and end members (Figure 1; elements 104 and 112 respectively) that are planar on their sides and are joined to form a rectangle, and a deck member (32) attached to the top side and enclosing the frame and a T-shaped bracket (Figure 2, element 38), the end of the bracket adapted for joining to a girder and the bracket flanges are fastened to the end member. Applicant should note that only the panel is positively claimed. The phrases "adapted for joining to one of said girders" subpart e and "for joining said end member to one of said girders" subpart f, is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

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Claims 3 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Badstieber (U.S. Patent No. 5,160,640).

Claim 3: Badstieber discloses a panel (Figure 1) having a plurality of structural members with a pair of elongated frame side members (1) and end members (3) joined at the ends to form a rectangular panel frame with a planar outer perimeter with top and bottom sides and a bracket (4) secured to an end member and extending outwardly therefrom (see Fig. 1, generally where the bracket portion does extend outwardly from the end member.)

Applicant should note that only the panel is being claimed. The phrase "for connecting said end member of said panel frame to one of said girders" subpart d is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 8: one of the structural members is rectangular.

Claims 13, 16, 17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Watson (U.S. Patent No. 4,603,532).

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Claim 13: Watson discloses a panel assembly (Figure 3), in combination with girders (Figure 4, element 18) comprising a plurality of structural members including side member (7) and end members (8) having planar surfaces, the members joined at their ends to form a rectangular panel having a planar outer perimeter, a deck member (3) on top of the frame, each panel positioned on a pair of girders (18, opposite of 18) and having fasteners (22) to the girders, and adjacent panel assemblies (3) having adjacent members thereof (see Fig. 3) positioned on the same girder (Fig. 3: generally) having end members connected by second fasteners.

Claim 16: the phrase "adapted to...panel assemblies", lines 5 and 6 is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 17: the frame members have a C-shape cross-section and the webs form a planar outer perimeter.

Claim 19: the framework is connected with a plurality of side members in spanning relationship.

Claims 20, 21, 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsuyama (U.S. Patent No. 5,934,033).

Claim 20: Matsuyama discloses a panel system with girders comprising a plurality of panels in combination with girders (Figure 2, element 16) comprising a plurality of rectangular members with side and end members (11 and 12) joined at their ends to form a rectangular panel with a planar outer perimeter, a deck member (14) attached to the top side of each frame, the frame is joined to the girders by bracket members (24), the bracket member extends outwardly therefrom, and the panels are joined in side-by-side relation.

Claim 21: the frame members have a C-shaped cross section (Figure 3). The phrase, "enable the webs...each of said frames", lines 5 and 6 is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 24: Matsuyama discloses a method of assembling panels by providing a plurality of panels (14), each having side and end members (11, 12) a bracket (24) attached to the deck member and extending outwardly therefrom, lifting the deck on girders

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(16), fastening the assembly using the brackets (24), and placing a second assembly on a span between a pair of girders (Figure 1), fastening the second assembly using brackets (24), and fastening one of the first assembly members with an adjacent one of the second frame members (Figure 1).

Claim 25: the fastening is performed below the assembly.

Claim 26: fastening a second assembly on a span between one of a pair of existing girders (16) and an additional girder (16) in an end-to-end relationship with the first assembly (Figure 1).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trimmer.

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Claims 9 and 11: Trimmer discloses the panels are joined in an end-to-end relationship but not in a side-to-side relationship. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to join the panels in a side-to-side relationship in order to make the panels in Trimmer adjust to the desired overall size and the prior art of record is capable of being made in such a manner.

Claims 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Badstieber in view of Watson.

Claim 13: Badstieber discloses a panel assembly having a plurality of structural side and end members (2) where the members are joined at their ends to form a rectangular panel, a deck member (3) secured to the top of the frame. Badstieber does not actually disclose a girder attached to the panel or adjacent panel assemblies having adjacent end members thereof positioned on a same girder (Fig. 4: generally) having end members connected by fasteners. Watson discloses a panel assembly attached to girders (Figure 4, element 18) and end members are positioned on a same girder and connected by second fasteners (22). It would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to use the panel in Badstieber with girders as in Watson because the panel in Badstieber can be used in such a manner and girders are well known in the art to be used with panels.

Claim 18: at least one of the members has a tubular rectangular cross-section (Badstieber: 2).

Response to Arguments

4. Applicant's arguments filed 15 June 2007 have been fully considered but they are not persuasive.

Regarding Applicant's argument that the amended claims teach around the prior art of record regarding the outward extension of "plates" and "liners" (page 16), the argument is not persuasive because the limitation "outward" is a limitation of relativity and as claimed does not provide further limitation to claim around the prior art of record (i.e. Applicant does not provide sufficient language to limit the direction of "outward".)

Regarding Applicant's argument the prior art of record does not specifically disclose that the panes are "roof or floor panels" page 16 and following, the argument is not persuasive because the prior art has the capability of being used as either

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roof or floor panels and so the limitation "roof or floor" is not given much patentable weight.

Regarding Applicant's argument of Claim 4 (page 17), this is not persuasive because Applicant did not positively claim the limitation of the girder, but only provides functional language (see rejection above).

Regarding Applicant's argument to Claim 13 (page 18), this is not persuasive because as claimed the limitation reads on a second assembly having adjacent end members on a same girder and having end members connected by second fasteners. The prior art of Watson clearly meets this limitation in that the end members of adjacent panel assemblies are connected by second fasteners (22: see Fig. 2).

Regarding Applicant's arguments addressing the labeling of portion 16 of the Matsuyama reference as a girder (pages 20, 21), the Examiner respectfully notes that portion 16 represents a girder in the broadest reasonable interpretation, and that the portion can be used in either a vertical or horizontal fashion.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is

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reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WVG

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AU 3635 8/30/07